

REMARKS

In the non-final Office Action of August 31, 2006, the Examiner rejects claims 1 and 8 as conflicting with claims 1 and 6 of HALL et al. (U.S. Patent Application Publication No. 2002/0061101); rejects claims 1, 5, and 8 under the judicially created doctrine of double patenting over claim 1, 2, 5, and 8 of GALLANT (U.S. Patent Application Publication No. 2002/0057693); rejects claims 1, 3, 5, 6, 8, 10-13, and 23 under 35 U.S.C. § 103(a) as unpatentable over GALLANT et al. (U.S. Patent No. 6,535,991) in view of NELSON et al. (U.S. Patent No. 6,895,088); objects to claims 2, 4, 7, and 9 as allowable if rewritten into independent form; and allows claims 14-21. Applicant respectfully traverses the above claim rejections.¹ Claims 1-21 and 23 remain pending.

Applicant notes with appreciation the indication that claims 2, 4, 7, and 9 would be allowable if rewritten into independent form. Moreover, Applicant appreciates the indication that claims 14-21 and 23 are allowable over the art of record.

Claims 1 and 8 stand rejected as allegedly conflicting with claims 1 and 6 of HALL et al. Applicant respectfully traverses this rejection.

37 C.F.R. 1.78(b) states:

[w]here two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.

Applicant submits that claims 1 and 8 of the present application and claims 1 and 6 of HALL et al. do not conflict.

Claim 1 of the present application recites, in part, an intelligent network comprising a multi-service control point operable to receive an input extracted from an input ATM setup message that includes a called party phone number value, a VToA designator, and a request to establish a point-to-multipoint connection, enforce policies regarding the establishment of point-to-multipoint connections, and generate an output in response for use in generating an output ATM setup message. Claim 1 of HALL et al. recites an intelligent network for use with an ATM network to set up an ATM switched virtual circuit to provide VToA services and closed user group services, the intelligent network comprising: a multi-service control point operable to receive an input extracted from an input ATM setup message that includes a called party phone number value and a VToA designator, execute a closed user group service to determine whether to authorize a VToA call between a calling party and a called party, and generate an output in response for use in generating an output ATM setup message; an ATM signaling intercept processor operable to intercept the input ATM setup message from an ingress ATM edge switch of the ATM network, extract the input from the input ATM setup message, communicate the input to the multi-service control point, receive the output generated by the multi-service control point, generate the output ATM setup message using the output, and communicate the output ATM setup message to the ingress ATM edge switch of the ATM network; and a service administration operable to provision the multi-service control point and the ATM signaling intercept processor. Claim 6 of HALL

et al. recites that the multi-service control point determines if the input ATM setup message requests an SVC for VToA by analyzing the VToA designator portion of the input.

The above feature recited in claim 1 of the present application is not identical to any feature recited in claim 1 or claim 6 of HALL et al. Moreover, this feature is patentably distinct from any feature recited in claim 1 or claim 6 of HALL et al. Thus, claim 1 does not conflict with claims 1 and 6 of HALL et al.

Claim 8 depends from claim 1. Therefore, claim 8 does not conflict with claims 1 and 6 of HALL et al. for at least the reasons given above with respect to claim 1.²

Claims 1, 5, and 8 stand rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1, 2, 5, and 8 of GALLANT. Applicant respectfully traverses this rejection.

A proper rejection under the judicially created doctrine of obviousness-type double patenting requires that the Examiner make clear (A) the differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. § 804. Applicant submits that the Examiner has not established a proper rejection under the judicially created doctrine of obviousness-type double patenting.

² As Applicant's remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

For example, the Examiner admits that distinct differences exist between claims 1, 5, and 8 of the present application and claims 1, 2, 5, and 8 of GALLANT (see pages 2-3 of the Office Action). The Examiner does not, however, explain why a person of ordinary skill in the art would conclude that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the patent. Instead, the Examiner makes conclusory allegations that the claims are not patentably distinct. Such conclusory allegations are insufficient for establishing a proper rejection under the judicially created doctrine of obviousness-type double patenting.

Applicant's claim 1 recites, *inter alia*, a multi-service control point operable to receive an input extracted from an input ATM setup message that includes a called party phone number value, a VToA designator, and a request to establish a point-to-multipoint connection, enforce policies regarding the establishment of point-to-multipoint connections, and generate an output in response for use in generating an output ATM setup message. Claims 1, 2, 5, and 8 of GALLANT do not disclose or suggest this combination of features. For example, claims 1, 2, 5, and 8 of GALLANT do not disclose or suggest a multi-service control point operable to receive an input extracted from an input ATM setup message that includes a called party phone number value, a VToA designator, and a request to establish a point-to-multipoint connection, and enforce policies regarding the establishment of point-to-multipoint connections, as recited in claim 1. The Examiner admits that claims 1, 2, 5, and 8 of GALLANT do not disclose this combination of features (Office Action, pg. 3). Moreover, Applicant submits that claim 1 is patentable distinct over claims 1, 2, 5, and 8 of GALLANT. Accordingly,

Applicant submits that the rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting is improper.

Claims 5 and 8 depend from claim 1. Therefore, Applicant respectfully requests that the rejection of these claims under the judicially created doctrine of obviousness-type double patenting be reconsidered and withdrawn for at least the reasons given above with respect to claim 1.

Claims 1, 3, 5, 6, 8, 10-13, and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over GALLANT et al. in view of NELSON et al. Applicant respectfully traverses this rejection.

Applicant respectfully submits that GALLANT et al. does not qualify as prior art under 35 U.S.C. § 103(a). 35 U.S.C. § 103(c) qualifies 35 U.S.C. § 103(a) and states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

GALLANT et al. qualifies as prior art under 35 U.S.C. § 102 only under subsection (e). The present application and the GALLANT et al. patent were, at the time the invention of the present application was made, owned by or subject to an obligation of assignment to MCI WorldCom, Inc. The GALLANT et al. patent was assigned to MCI WorldCom, Inc. and recorded at Reel 010493, Frame 0561 on January 11, 2000. The present application contains an assignment, dated January 21, 2001, from the inventor to MCI WorldCom, Inc., which has been recorded at Reel 011574, Frame 0673. Accordingly, the GALLANT et al. patent is not available to preclude patentability under

35 U.S.C. § 103(a).

Applicant submits that claims 1, 3, 5, 6, 8, 10-13, and 23 are patentable over NELSON et al.

For at least the foregoing reasons, Applicant submits that the rejection of claims 1, 3, 5, 6, 8, 10-13, and 23 under 35 U.S.C. § 103(a) based on GALLANT et al. and NELSON et al. is improper. Applicant respectfully requests that the rejection be withdrawn.

In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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